

## **REMARKS**

Applicant appealed the final rejection of claims 1, 2, and 9. The Board of Patent Appeals and Interferences (BPAI) reversed the final rejection and remanded the application for findings of fact and conclusions of law with respect to Mayer (U.S. Patent No. 6,578,939). The present Office Action rejects claims 1, 2 and 9 under 35 U.S.C. § 103(a) as being unpatentable over admitted prior art (APA) in view of Drake (U.S. Patent No. 6,746,193) and further in view of Mayer (U.S. Patent No. 6,578,939). Applicant respectfully traverses the rejection and requests reconsideration.

Drake discloses a nut with a square locating surface that fits into a square hole. Mayer discloses a washer with a raised circular center portion for centering a screw within a square hole. The Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify Drake to have a circular locating surface. Perhaps. However, the Office Action further asserts that it would have been obvious to transfer the locating surface of Drake's nut and the circular center portion of Mayer's washer to a fastener head. With this assertion, applicant respectfully disagrees.

Notably, the BPAI did not reach the decision as to whether it would be obvious to transfer the features of Drake and Mayer to a fastener head as claimed by the applicant. In one place, the BPAI's opinion states: “Assuming arguendo that the teaching of the locating surface 110 on the nut disclosed in Drake would have suggested the use of a locating surface on a fastener head as claimed . . . .” Emphasis added. In another place, the opinion states: “[E]ven if we assume the obviousness of transferring a locating surface from a nut to a fastener head ....” Emphasis added. From these excerpts it can be seen that the BPAI assumes obviousness merely for the sake of argument,

and reaches no conclusion on this issue. Therefore, the issue of obviousness regarding the transfer of Drake's and Mayer's features to a fastener head remains to the Examiner for findings of fact and conclusions of law.

The Examiner's findings of fact, however, appear to rely on "common knowledge" or "implicit suggestion", in effect taking "official notice". The Office Action simply states, "[I]t would have been obvious for one of ordinary skill in the art to provide the screw of the APA with a shoulder as disclosed in Drake for the same economic reasons as described therein." To rely on "economic reasons" as the motivating incentive for creativity, in effect, conveniently and effectively renders many, if not all, patented and patentable inventions obvious. Yet, the Examiner provides no scientific or technical evidentiary support as to why one of ordinary skill would even think of transferring the features of nuts and washers to a screw.

The MPEP § 2144.03 states:

It is *never* appropriate to rely solely of "common knowledge" in the art *without evidentiary support* in the record, as the principal evidence upon which a rejection is based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather the board *must* point to some *concrete evidence* in the record to support these findings.") Emphasis added.

MPEP § 2144.03 further states:

If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner *must* provide specific *factual findings* predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. (The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice

and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.) (Emphasis added).

The Examiner provides no evidentiary support as to why it is well known for one of ordinary skill in the art to transfer the features of nuts and washers to a fastener head. As such, the Examiner is depriving the applicant of the ability to challenge the Examiner's basic assertion, which clearly violates MPEP directives. Therefore, applicant respectfully requests that the Examiner provide evidentiary support by citing prior art or submitting an affidavit to establish a basis for this assertion, or otherwise withdraw the rejection.

### **CONCLUSION**

In view of the arguments made herein, applicant respectfully submits that the application is in condition for allowance, and therefore requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the applicant's representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-0932.

Respectfully submitted,

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